

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action mailed January 19, 2005. At the time of the Office Action, Claims 1-70 were pending in the Application. Applicant amends Claims 1, 6, 11, 16, 21, 26, 31, 36, 47, 55, and 63 and cancels Claims 5, 15, 25, and 35 without prejudice or disclaimer. The amendments and cancellations to these claims are not the result of any prior art reference and, thus, do not narrow the scope of any of the claims. Furthermore, the amendments are not related to patentability issues and only further clarify subject matter already present. All of Applicant's amendments have only been done in order to advance prosecution in this case. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Allowable Subject Matter

Applicant notes with appreciation the Examiner's allowance of Claims 47, 55, and 63 and the Examiner's indication that the subject matter of these claims would be allowable if rewritten in Independent form including all of the limitations of the base claim and any intervening claims (See Pending Office Action, p. 4). Applicant has rewritten these claims in an Independent format. Note that any amendments in this response that implicate the deemed "allowable subject matter" should not be construed as an agreement with, or an acquiescence to, the propriety of the purported allowable subject matter as compared to the rejected claims. Applicant earnestly believes all of the pending claims are allowable in their original form. Applicant reserves the right to comment on the appropriateness of the allowed subject matter designation at a future time, should Applicant deem it appropriate to do so.

Section 102 Rejections

The Examiner rejects Claims 1, 10-11, 20-21, 30-31, and 40 under 35 U.S.C. §102(e), as being anticipated by U.S. Publication No. 2002/0037744 issued to Bhatia et al. (hereinafter "*Bhatia*"). This rejection is respectfully traversed for the following reasons.

Independent Claim 1, as amended, recites:

A method for providing service trigger management in a wireless network, comprising:

generating, at an application of a mobile unit, an application level signaling message associated with a network session, wherein the message is communicated to a serving node such that the serving node is made aware of session activity of the mobile unit; and

determining allowability of the session, through out-of-band communications, based on a service agreement without accessing external resources.

Applicant respectfully reminds the Examiner that a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.¹ In addition, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claims" and "[t]he elements must be arranged as required by the claim."² In regard to inherency of a reference, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic."³ Thus, in relying upon the theory of inherency, an Examiner must provide a basis in fact and/or technical reasoning to support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.⁴

Using the preceding well-settled jurisprudence, it is clear that *Bhatia* fails to anticipate Independent Claim 1. For example, *Bhatia* fails to teach, suggest, or disclose generating ... an application level signaling message associated with a network session, wherein the message is communicated to a serving node such that the serving node is made aware of session activity of the mobile unit, and determining allowability of the session, through out-of-band communications, based on a service agreement without accessing external resources. Indeed, the Examiner concedes as much in his analysis and concluded that *Bhatia* does not teach such operations. (See Current Office Action: page 4.) Thus, the

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987); MPEP §2131.

² *Richardson v. Suzuki Motor Co.*, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989); *In re Bond*, 15 USPQ 2d 1566 (Fed. Cir. 1990); MPEP §2131 (*emphasis added*).

³ MPEP §2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ 2d 1955, 1957 (Fed. Cir. 1993) (*emphasis in original*)).

⁴ MPEP §2112 (citing *Ex Parte Levy*, 17 USPQ 2d 1461, 1464 (Bd. Pat. at App. and Inter. 1990) (*emphasis in original*)).

Examiner acknowledges the deficiencies of *Bhatia*. Accordingly, Independent Claim 1 is patentable over *Bhatia*. Additionally, Independent Claims 11, 21, 31, 41, 49, and 57 recite similar limitations and, thus, are also allowable using similar reasoning. In addition, their corresponding dependent claims are also allowable over *Bhatia* for analogous reasons. Notice to this effect is respectfully requested.

Section 103 Rejections

The Examiner rejects Claims 2-9, 12-19, 22-29, 32-39, 41-46, 48-54, 56-62, and 64 under 35 U.S.C. §103(a), as being unpatentable over *Bhatia* and further in view of U.S. Publication No. 2002/0065064 issued to Griffith et al. (hereinafter "*Griffith*"). This rejection is respectfully traversed for the following reasons.

Applicant respectfully reminds the Examiner that to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation; either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior reference (or references when combined) must teach or suggest all of the claim limitations.⁵

It is respectfully submitted that the rejected claims are patentable over the art of record based on at least the third criterion of obviousness: none of the references alone or in combination teach, suggest, or disclose each and every claim limitation of the Independent Claims. This issue has been highlighted in the §102 analysis above, but will be expounded on in the subsequent paragraphs for purposes of assisting the Examiner.

As pointed out above, Independent Claim 1 includes: generating ... an application level signaling message associated with a network session, wherein the message is communicated to a serving node such that the serving node is made aware of session activity of the mobile unit, and determining allowability of the session, through out-of-band communications, based on a service agreement without accessing external resources.

In contrast to these teachings, neither *Bhatia* nor *Griffith* offer any architecture that offers these out-of-band operations. In the Office Action, the Examiner concedes that such a

⁵ See M.P.E.P. §2142-43.

functionality is simply missing from the asserted references. (See Office Action: page 4.) In addition, the Examiner failed to offer any additional disclosure that relates to this subject matter. This absence of support in the cited references is presumably because these references lack these missing items. Evaluating *Bhatia* and *Griffith* more closely confirms that these elements are simply not found therein. For at least these reasons, this subject matter is patentably distinct from *Bhatia* and *Griffith*.

Applicant also wishes to note that even if these elements of Independent Claim 1 were disclosed in the cited references, which they are not, usage of the *Bhatia* reference or of the proposed *Bhatia-Griffith* combinations is still improper because the Examiner has not shown the required suggestion or motivation in *Bhatia* or in *Griffith*, or in the knowledge generally available to one of ordinary skill in the art at the time of the invention to combine these references. The mere fact that references *can* be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.⁶ Thus, the sheer fact that the teachings of one reference would improve the teachings of another reference, as the Examiner asserts, does not provide the required suggestion to combine. The U.S. Court of Appeals for the Federal Circuit has held that the fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggests the desirability of the modification.⁷

Nothing in *Bhatia* or in *Griffith* suggests or motivates the proposed combination, nor has the Examiner provided evidence that suggests or motivates the proposed combination.⁸ This is because the references fail to include the above-identified functionality and, therefore, are precluded from rendering the pending claims unpatentable. Speculation in hindsight that “it would have been obvious” to make the proposed combination because the proposed combination would be helpful is insufficient under M.P.E.P.⁹ guidelines and governing

⁶ M.P.E.P. §2143.01 (emphasis in original).

⁷ *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992).

⁸ If “common knowledge” or “well known” art is being relied on to combine the references, Applicant respectfully requests that a reference be provided in support of this position pursuant to M.P.E.P. §2144.03. If personal knowledge is being relied on to supply the required motivation or suggestion to combine, Applicant respectfully requests that an affidavit supporting such facts be provided pursuant to M.P.E.P. §2144.03.

⁹ See M.P.E.P. §2145 X.C. (“The Federal Circuit has produced a number of decisions overturning obviousness rejections due to a lack of suggestion in the prior art of the desirability of combining references.”).

Federal Circuit case law.¹⁰ The M.P.E.P. consistently confirms that this approach is improper and, thus, it should not be used here.¹¹ Moreover, under the M.P.E.P., such statements and assumptions are inadequate to support a finding of motivation, which is a factual question that cannot be resolved on “subjective belief and unknown authority.”¹² Under such circumstances, the Examiner must point to some concrete evidence in the record in support of the rejection, rather than relying on an assessment of what is “well recognized” or what a skilled artisan would be “well aware.”¹³

In the context of the second criterion of non-obviousness, the Examiner has also failed to show a reasonable expectation of success for the proposed combinations. Therefore, Applicant respectfully submits that the Examiner has also failed to establish the second criteria for a prima facie case of obviousness.

Independent Claims 11, 21, 31, 41, 49, and 57 recite limitations similar, but not identical, to those recited in Independent Claim 1. Therefore, these claims are also allowable, for example, for the same reasons as identified above. Additionally, the corresponding dependent claims from these Independent Claims are also patentably distinct for analogous reasons.

Accordingly, all of the pending claims have been shown to be allowable as they are patentable over the references of record. Notice to this effect is respectfully requested in the form of a full allowance of these claims.

¹⁰ For example, in *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999), the Federal Circuit reversed a finding of obviousness by the Board of Patent Appeals and Interferences, explaining that evidence of a suggestion, teaching, or motivation to combine is essential to avoid impermissible hindsight reconstruction of an applicant’s invention:

Our case law makes clear that the best defense against the subtle but powerful attraction of hindsight obviousness analysis is *rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references*. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

175 F.3d at 999 (quoting *W.L. Gore & Assoc., Inv. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)) (emphasis added) (citations omitted). See also *In Re Jones*, 958 F.2d 347 (“Conspicuously missing from this record is any evidence, other than the PTO’s speculation (if that can be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modification of the prior art salts necessary to arrive at [the claimed invention].”).

¹¹ See M.P.E.P. §2145.

¹² See *In re Lee*, 277 F.3d 1338, 1344 (Fed. Cir. 2002).

¹³ See *In re Zurko*, 258 F.3d 1379, 1385-86 (Fed. Cir. 2001).


CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for all other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant believes that no fee is due. If, however, this is not correct, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicant invites the Examiner to contact its attorney, Thomas J. Frame, at (214) 953-6675.

Respectfully submitted,
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